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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,689	07/21/2003	Shaoxing Lu	237687US0	4413

22850 7590 06/09/2005

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,689

Applicant(s)

LU ET AL.

Examiner

Kuo-Liang Peng

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/29/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-4, 10-12, 18-19, 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-4, 10-12, 18-19, 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/1/04, 11/16/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on March 29, 2005 was received. Claims 1-2, 5-9, 13-17 and 20-21 are deleted. Claims 22-34 are added. Now, Claims 3-4, 10-12, 18-19 and 22-34 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Oodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 17 of copending Application No. 10/666,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 17 of the copending Application is

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directed to an emulsion comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 10/166,760. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 2 of the copending Application is directed to an emulsion comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 17 of copending Application No. 10/166,755. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 17 of the copending Application is directed to an emulsion comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 25 and 66 of copending Application No. 10/170,655. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claims 25 and 66 of the copending Application is directed to compositions comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 10 and 57 of copending Application No. 10/170,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claims 10 and 57 of the copending Application are directed to compositions comprising a copolymer of formula (I), which obviously read on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 18 and 62-63 of copending Application No. 10/170,549. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claims 18 and 62-63 of the copending Application are directed to compositions comprising a copolymer of formula (I), which obviously read on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 10/320,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 2 of the copending Application is directed to a composition comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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10. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 10/320,599. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 2 of the copending Application is directed to compositions comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 10/320,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 2 of the copending Application is directed to compositions comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 10/166,650. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 2 of the copending Application is directed to compositions comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 10-12, 18-19 and 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 66 of copending Application No. 10/935,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. Claim 66 of the copending Application is directed to compositions comprising a copolymer of formula (I), which obviously reads on the composition of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 1104).

Claim Rejections - 35 USC § 102

15. Rejection of Claims 3-4, 10-12 and 18-19 under 35 USC 102(e) as being anticipated by Lu (US 2004/0001799) is maintained because the rejection is adequately set forth in paragraph 3 of Paper No. 1104. The newly added Claims 22-34 can also be rejected. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants primarily argue that Lu does not contain required oxyalkylene group. (Remarks, page 5, 1st paragraph). However, note that X in formula (I) can be an oxyalkylene group. ([0043]) For Claims 22-34, Lu further discloses formula (III) or (IV) wherein n in formula (III) or (IV) is described in [0084], which reads on Applicants' polymer with the specific w set forth in the instant claims.

16. Rejection of Claims 3-4 and 10 under 35 USC 102(b) as being anticipated by Wittmann (US 4 822 852) is maintained because the rejection is adequately set forth in paragraph 3 of Paper No. 1104. The newly added Claims 22-23 and 27-28 can also be rejected. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants primarily argue that Wittmann's copolymer has a different structure from that of Applicants' copolymer. Particularly, Applicants argue, "... in Wittmann's copolymers, oxygen bonds directly to the silicone atom (Z-X-O-Si-O.....), whereas no such directly-bound oxygen bond exists in the claimed copolymers." (Remarks, page 4, last paragraph) This argument is not persuasive because there is nothing specifically mentioned about how Si is bonded to other segment(s) in the present invention. Furthermore, note that when p is 0 in formula (I), the copolymer also reads on the copolymer in the present invention as mentioned in the previous Office action. For Claims 22-23 and 27-28, note that when p is 1, the copolymer is derived from at least one segment of formula II. When p is 0 or 1, the copolymer can contain at least one polyoxyalkylene. (col. 4, lines 57-66)

17. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Lu548 (US 2003/0235548).

Lu548 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in a cosmetic emulsion composition. ([0002]-[0003] and [0139]-[0154]) Lu548 further discloses formula (III) or (IV) ([0177]-[0178]) wherein n in formula

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(III) or (IV) is described in [0185], which reads on Applicants' polymer with the specific w set forth in the instant claims.

18. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Lu553 (US 2003/0235553).

Lu553 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0001], [0035] and [0044]-[0060]) Lu553 further discloses formula (III) or (IV) ([0085]-[0095]) wherein n in formula (III) or (IV) is described in [0093], which reads on Applicants' polymer with the specific w set forth in the instant claims.

19. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansenne (US 2004/0126336).

Hansenne discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0001], [0005] and [0099]-[0115]) Hansenne further discloses formula (III) or (IV) ([0137]-[0148]) wherein n in formula (III) or

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(IV) is described in [0146], which reads on Applicants' polymer with the specific w set forth in the instant claims.

20. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu552 (US 2003/0235552).

Yu552 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0002], [0034] and [0118]-[0133]) Yu552 further discloses formula (III) or (IV) ([0157]-[0167]) wherein n in formula (III) or (IV) is described in [0165], which reads on Applicants' polymer with the specific w set forth in the instant claims.

21. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(a),(e) as being anticipated by Tournilhac (US 2003/0072730).

Tournilhac discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0002], [[0106]-[0122] and [0299]) Tournilhac further discloses formula (III) or (IV) ([0147]-[0158]) wherein n in formula (III) or

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(IV) is described in [0156], which reads on Applicants' polymer with the specific w set forth in the instant claims.

22. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferrari188 (US 2003/0170188).

Ferrari188 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0002], [0094]-[0109], [0284] and [0289]) Ferrari188 further discloses formula (III) or (IV) ([0134]-[0145]) wherein n in formula (III) or (IV) is described in [0143], which reads on Applicants' polymer with the specific w set forth in the instant claims.

23. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(a),(e) as being anticipated by Ferrari348 (US 2003/0068348).

Ferrari348 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0002], [0073]-[0088], [0264] and [0270]) Ferrari348 further discloses formula (III) or (IV) ([0113]-[0125]) wherein n in

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formula (III) or (IV) is described in [0123], which reads on Applicants' polymer with the specific w set forth in the instant claims.

24. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu154 (US 2004/0115154).

Yu154 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0001]-[0002], [0030]-[0046] and [0274]) Yu154 further discloses formula (III) or (IV) ([0070]-[0080]) wherein n in formula (III) or (IV) is described in [0078], which reads on Applicants' polymer with the specific w set forth in the instant claims.

25. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu153 (US 2004/0115153).

Yu153 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0001]-[0002], [0030]-[0046], [0247] and [0315]) Yu153 further discloses formula (III) or (IV) ([0071]-[0081]) wherein n in

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formula (III) or (IV) is described in [0079], which reads on Applicants' polymer with the specific w set forth in the instant claims.

26. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu912 (US 2004/0120912).

Yu912 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0001]-[0002], [0031]-[0047] and [0243]-[0244]) Yu912 further discloses formula (III) or (IV) ([0071]-[0082]) wherein n in formula (III) or (IV) is described in [0080], which reads on Applicants' polymer with the specific w set forth in the instant claims.

27. Claims 3-4, 10-12, 18-19 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Lu030 (US 2003/0232030).

Lu030 discloses a copolymer represented by formula (I) containing X groups which can be oxyalkylene moieties in the backbone. The copolymer can be used in an emulsion composition. ([0001]-[0002], [0043]-[0059] and [0348]) Lu030 further discloses formula (III) or (IV) ([0084]-[0094]) wherein n in formula

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(III) or (IV) is described in [00092], which reads on Applicants' polymer with the specific w set forth in the instant claims.

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 24-26 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wittmann.

Wittmann discloses a composition comprising a copolymer as described in the previous Office action, which is incorporated herein by reference. Wittmann is silent on the specific number of segments of polyoxyalkylene set forth in the instant claims. However, Wittmann teaches that the amount of polyoxyalkylene in the copolymer can affect the properties of the copolymer. (col. 5, lines 8-15) In other words, the number of polyoxyalkylene is a Result-Effective variable.

Therefore, it would have been obvious to one of ordinary skilled in the art at the

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time of the invention was made to incorporate whatever number of polyoxyalkylene through routine experimentation in order to obtain a copolymer with desired properties. Especially, Applicants do not show the criticality of the number of polyoxyalkylene. See MPEP 2144.05 (II).

30. The references cited in LIST OF RELATED CASES filed on November 16, 2004 have been considered.

31. The references, US 4 822 852 and US 2004/0001799, cited in the information disclosures filed on December 1, 2004 and November 16, 2004, respectively, have been lined through because they were cited in PTO-892 form of Paper No. 1104.

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed

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within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about

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the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

June 1, 2005



Kuo-Liang Peng
Primary Examiner
Art Unit 1712